

I. Status of the Application

Claims 8-27 are pending in this application. In the November 27, 2007 office action, the Examiner:

- A. Objected to claims 8-27 for various informalities;
- B. Rejected claims 8-27 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite;
- C. Rejected claims 8-11, 16-19 and 24-27 under 35 U.S.C. § 103(a) as allegedly being obvious over US Patent No. 6,104,696 to Kadambi et al. (hereinafter Kadambi) in view of US Publication No. 2002/0071398 to Moran et al. (hereinafter "Moran"); and
- D. Rejected claims 12-15 and 20-23 under 35 U.S.C. § 103(a) as allegedly being obvious over Kadambi in view of Moran and further in view of U.S. Patent No. 6,356,951 to Gentry, Jr.

In this response, applicants have amended claims 8-17, 19, 24 and 25 and cancelled claim 18.

II. The Objection to Claims 8-27 Should Be Withdrawn

In the November 27, 2007 Office action, the examiner objected to claims 8-27 for containing undefined acronyms. Applicant has amended claims 8-27 to define all acronyms. Accordingly, it is respectfully submitted that the examiner's objection to the claims should be withdrawn.

III. The Rejection of Claims 8-27 Under 35 U.S.C. § 112, Second Paragraph, Should Be Withdrawn

In the November 27, 2007 Office action, the examiner rejected claims 8-27 under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully submit that the examiner's rejection under 35 U.S.C. § 112, second paragraph, is moot in view of the foregoing amendments to claims 8, 17 and 24.

IV. The Rejection of Claims 8, 17 and 24 Under 35 U.S.C. § 103(a) Should Be Withdrawn

In the November 27, 2007 office action, the Examiner rejected claims 8, 17 and 24 under 35 U.S.C. § 103(a) as being unpatentable over Kadambi in view of Moran. In this response, Applicant respectfully traverses the Examiner's rejection of claims 8, 17 and 24 under 35 U.S.C. § 103(a).

In order to establish a *prima facie* case of obviousness, the prior art references when combined must teach or suggest all the claim limitations. MPEP § 2143.03. Furthermore, there must be some suggestion or motivation to modify the references or combine reference teachings. MPEP § 2143.01. In addition, pursuant to MPEP 2143, "*the key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.*"

A. The References Do Not Teach or Suggest All Claim Limitations

In the present case, it is respectfully submitted that Kadambi and Moran, either alone or in combination, teach or suggest all the limitations of claims, 8, 17 and 24. .

One example of a limitation of claim 8 that is not taught or suggested by the cited references is that of “a plurality of ports (n) ... wherein at least a portion of the plurality of ports are switchable between two modes in which the portion of the plurality of ports operate respectively as one GE port or a plurality of FE ports (m), and wherein there are m MAC interfaces per port, wherein the switch is configured to operate as n GE ports and m (m-n) FE ports where n is a selectable integer greater than 1 and m is an integer greater than 1.” Claims 17 and 24 include similar limitations to the foregoing limitation of claim 8.

The foregoing limitation provides for an Ethernet switch having a plurality of ports where the full bandwidth of each port may be utilized. In particular, claim 8 sets forth that the ports may operate between two modes as either a single GE port or as multiple FE ports. By contrast, neither the Kadambi nor Moran references disclose an Ethernet switch having a plurality of ports configured to operate two modes wherein the plurality of ports operate as a *single* GE port in a first mode and the plurality of ports operate as *multiple* FE ports in the second mode.

Previously presented claim 19 included a limitation that is similar to the foregoing limitation included in amended claims 8, 17 and 24. In particular, previously presented claim 19 included the limitation of a port “being switchable between two modes, a first mode operating as one GE port and a second mode operating as [multiple] FE ports.” At page 5 of the November 27, 2007 Office action, the examiner stated that “Kadambi does

not teach a controller that will negotiate between FE and GE.” The examiner then argued that Moran teaches this limitation by “disclosing Ethernet MAC controllers capable of negotiating between 10/100/1000 Mbps transmission rates.” However, in contrast to the examiner’s assertion, Moran does not disclose the limitation of amended claim 8 of an Ethernet switch having a plurality of ports configured to operate two modes wherein the plurality of ports operate as a *single* GE port in a first mode and the *plurality* of ports operate as multiple FE ports in the second mode. Applicant respectfully submits that there is no possibility of any of the ports in Moran operating as a *single* GE port or *multiple* FE ports. The ports of Moran are only capable for operation as a single FE port. Therefore, in the FE port of Moran, the bandwidth of the port would be seriously underutilized, as much of its processing capacity is unused. By contrast, a port configured as set forth in claim 8 can be operated at much the same bandwidth (whether as a GE or as multiple FE ports), so its processing capacity is used efficiently. According to the arrangement of amended claim 8, in the FE mode, the full bandwidth of each port may be utilized.

As set forth above, neither Kadambi nor Moran teach “a plurality of ports (n) ... wherein at least a portion of the plurality of ports are switchable between two modes in which the portion of the plurality of ports operate respectively as one GE port or a plurality of FE ports (m)”. Therefore it is respectfully submitted that all the limitations of claim 8, are not taught or suggested by the cited references, and Examiner’s rejection of claim 8 under 35 U.S.C. 103(a) should be withdrawn. For similar reasons, it is respectfully submitted that the examiner’s rejection of claims 17 and 24 should be withdrawn.

B. The Examiner Has Not Provided a Suggestion or Motivation to Combine Reference Teachings

In addition to the foregoing, it is respectfully submitted that the examiner has failed to make a prima facie case of obviousness because the examiner has not provided a suggestion or motivation to modify the references or combine reference teachings as required under MPEP § 2143.01.

There are three possible sources for a motivation to combine references: the nature of the problems to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art.” *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998). Furthermore, obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so. MPEP § 2143.01 (emphasis added). “Rejections on obviousness cannot be sustained with mere conclusory statements; instead there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” MPEP § 2142.

In the November 27, 2007 Office action, the Examiner failed to establish a motivation for combining Kadambi and Moran. Instead, on pages 3-4 of the Office action, the Examiner proposed different features shown in Kadambi and Moran. Then, on page 4 of the Office action, the Examiner simply stated that “it would have been obvious to a person of ordinary skill in the art at the time of the invention to use separate send and receive modules in Kadambi’s invention to allow for a more efficient way to locate buffered frames not having to search one large pool to locate a particular packet.”

Applicant respectfully submits that a rationale of “a more efficient way to locate buffered frames” is no more than an improper “conclusory statement” in providing support for a finding of obviousness. Absent a clear analysis and rationale for combining references as set forth above in MPEP § 2142-2144, the Examiner’s conclusory statement is merely impermissible “hindsight.”

Applicant respectfully questions why one of skill in the art would be interested in combining Kadambi and Moran, and where is the motivation in the art for doing so? Should the examiner maintain the rejection under 35 U.S.C. § 103, it is respectfully submitted that the examiner should provide “articulated reasoning with some rational” (as required under MPEP § 2142) for the conclusion that combining Kadambi and Moran would be obvious and would result in all the claim limitations.

In view of the foregoing, it is respectfully submitted that the examiner’s rejection of claims 8, 17 and 24 under 35 U.S.C. § 103(a) should be withdrawn.

V. The Rejection of Dependent Claims 9-16, 18-23 and 25-27 Should Be Withdrawn

In the November 27, 2007 Office action, the Examiner rejected dependent claims 9-16, 18-23 and 25-27 under 35 U.S.C. § 103(a). Each of these dependent claims depends from and incorporates all of the limitations of one of independent claims 8, 17 or 24. As set forth above, the Examiner’s rejection of claims 8, 17 or 24 should be withdrawn. Therefore, because each of dependent claims 9-16, 18-23 and 25-27 depends from and incorporates all of the limitations of one of independent claims 8, 17 or 24, the examiner’s rejection of dependent claims 9-16, 18-23 and 25-27 should also be withdrawn for at least the same reasons.

VI. Conclusion

For all of the foregoing reasons, it is respectfully submitted the applicant has made a patentable contribution to the art. Favorable reconsideration and allowance of this application is therefore respectfully requested.

In the event applicant has inadvertently overlooked the need for an extension of time or payment of an additional fee, the applicant conditionally petitions therefore, and authorizes any fee deficiency to be charged to deposit account 13-0014.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read "Russ Fowler", with a long horizontal flourish extending to the right.

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